

Atty. Dkt. No. 025782-0108 f/k/a 035451-0129 (3631.Palm)

REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

Claims 1-20 are currently pending in the application. No claim amendments are made.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier for each.

Claim Rejections – 35 U.S.C. § 112 ¶ 1

In the Office Action, claims 10-20 are rejected under 35 U.S.C. § 112 ¶ 1 as failing to comply with the enablement requirement because “the specification pages 8 and 9, paragraph [0021]; pages 10 and 11, paragraph [0024] do not provide how the handheld computer has been modified by the launching application program to provide the necessary functionality need by the email application.” In order to make an enablement rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). Applicants respectfully submit that the Examiner has not met the initial burden of establishing a reasonable basis to question the enablement provided for the subject matter of claims 10-20. Other than the above-cited statement asserting information not provided, the Office Action neither provides no analysis of factors, reasons, and evidence, that led the Examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, nor explains why one skilled in the art could not supply the information asserted to by missing without undue experimentation, as is required to meet the initial burden. See Manual of Patent Examining Procedure §§ 2164.04, 2164.06(a).

Applicants also respectfully submit that it is not required that Applicants describe in their specification the particularities of modification beyond that which has been disclosed in order to

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meet the requirements of 35 U.S.C. § 112 ¶ 1. All that is necessary is that one of ordinary skill in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. See In re Buchner, 929 F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991). Applicants respectfully submit that the present specification makes clear various types of incompatibilities that may exist between software applications and handheld computers such that the software application is not configured for use with the handheld computer and modified behavior is required to run the software application on the handheld computer (see, e.g., paragraph [0019]). One of ordinary skill in the art is able to determine the particular parameters that need to be changed for a particular handheld computer based on, for example, a particular e-mail application to be used with a particular wireless connection, so that the application may be used on the handheld computer. Upon reviewing Applicants' specification, one of ordinary skill in the art would be able to follow Applicants' teachings as described therein regarding the use of a launching application to provide such a launching application to modify the particular parameters needing to be changed. For example, paragraphs [0020]-[0024] provide several examples of using a launching application to modify parameters of a handheld computer. Accordingly, Applicants respectfully request that the rejection of claim 10 (and claims 11-14 which depend therefrom) and claim 15 (and claims 16-20 which depend therefrom) under 35 U.S.C. § 112 ¶ 1 be withdrawn.

In the Office Action, claims 17-19 are also rejected under 35 U.S.C. § 112 ¶ 1 as failing to comply with the written description requirement because "[t]he recited limitations are not supported by the specification." In order to make a written description rejection, the Examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. See In re Wertheim, 541 F.2d 257, 263, 169 U.S.P.Q. 90, 97 (C.C.P.A. 1976). Applicants respectfully submit that the Examiner has not met the initial burden of setting forth express findings of fact as to why a person of ordinary skill in the art would not recognize in Applicants' disclosure a description of the subject matter of claims 17-19. More specifically, regarding original claims filed in an application, there is a strong presumption that an adequate

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written description of the claimed invention is present. See Id.; Manual of Patent Examining Procedure § 2163 (I)(A). Applicants respectfully submit that the Office Action fails to meet the initial burden of overcoming the strong presumption of an adequate written description with regard to original claims 17-19 by setting forth the simple statement that “[t]he recited limitations are not supported by the specification.” Applicants also respectfully submit that sufficient written description of the types of incompatibilities recited in claims 17-19 is provided, for example, in paragraph [0019] of the specification, and that functional examples are included, for example, in paragraphs [0020]-[0024]. These examples provide evidence that Applicants were in possession of the claimed invention. Accordingly, Applicants respectfully request that this rejection of claims 17-19 under 35 U.S.C. § 112 ¶ 1 be withdrawn.

Claim Rejections – 35 U.S.C. § 102(e)

In the Office Action, claims 10-15 and 17-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Narayanaswami (U.S. Patent No. 6,678,535). The Office Action indicates that Narayanaswami teaches all of the claim limitations of Claims 10 and 15. As an initial matter, Applicants reserve the right to swear behind Narayanaswami in future proceedings if necessary.

The Office Action states with regard to claims 10 and 15 that Narayanaswami teaches “providing an email application not configured for use over a wireless connection on a handheld computer” at column 10, lines 9-12. To this assertion, Applicants disagree. What is disclosed in Narayanaswami is that transcoder device software on a content transcoder device converts received data into a format which is used by the content transcoder device or other devices. Applicants respectfully submit that the transcoder device software is not the same as an e-mail application (much less an e-mail email application that is not configured for use over a wireless connection), and that converting received data by the device is also not the same as providing an e-mail application that is not configured for use over a wireless connection. Narayanaswami does not describe providing any type of e-mail application that is not configured for use over a wireless connection.

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The Office Action further states that "Narayanaswami discloses a smart pervasive dock protocol adapter 500 equipped with a content transcoder device 530 for transcoding received data on the fly, such as a huge e-mail message that is eventually destined to be received by the Wrist Watch). Applicants respectfully submit that a "huge e-mail message" is not the same as an e-mail application, nor does its presence somehow make the transcoder device software on the content transcoder device an e-mail application (much less an e-mail email application that is not configured for use over a wireless connection). Further, if the Office Action is intended to indicate that Narayanaswami discloses that the e-mail application is on the wristwatch, Applicants would submit that Narayanaswami provides no indication that such an e-mail application is disclosed as not being configured for use over a wireless connection. Furthermore, Applicants claim that the e-mail application is on the handheld computer, and that the launching application is also on the handheld computer and modifies parameters of the handheld computer. The Office Action appears to indicate that the application that changes parameters is on the dock protocol adapter. However, the transcoder device software on the content transcoder device only converts data to be sent from the dock protocol adapter to the wrist watch from one form to another. Applicants have claimed that the handheld computer has both the launching application that changes parameters and the e-mail application.

With regard to claim 10, the e-mail application provided in claim 10 is "not configured for use over a wireless connection." Narayanaswami does not disclose, teach, or suggest the use of an e-mail application that is not configured for use over a wireless connection. What is taught by Narayanaswami is a transcoding application which converts data from one form to another. This is not an e-mail application as claimed by Applicants.

With regard to claim 15, Applicants have claimed use of an application that was not intended to be used with a handheld computer. Therefore, the application provided in claim 15 is "not configured not configured to run on the handheld computer." Narayanaswami does not disclose, teach, or suggest the use of an application that is not configured to run on a handheld computer. What is taught by Narayanaswami is a transcoding application which enables data to

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be converted from an original format to a format which may be more suitable for a smaller device, such as the wristwatch device described. Narayanaswami does not describe the enabling use of an application on an unintended platform, rather Narayanaswami teaches enabling the use of data on a device which it was not intended for.

Further, the Office Action indicates that Narayanaswami discloses “modifying parameters of the handheld computer, by the launching application, so that the e-mail application is able to use a wireless connection.” Applicants respectfully submit that this claim limitation is not taught or disclosed by Narayanaswami. Narayanaswami teaches converting data in one format to data in a second format so that it can be easily viewed on a smaller device.

Claim 10 recites “modifying parameters of the handheld computer...”, whereas Narayanaswami teaches modifying data transmitted to the smaller device. This is not the modification of parameters for the handheld computer, rather than simply a conversion of data. Further, Applicants respectfully submit that the parameters in claim 10 are modified by the launching application which is on the handheld computer, whereas Narayanaswami teaches modifying data on one device using transcoder software and then transmitting the converted data to a second device to be used by the second device. Further still, Applicants respectfully submit that the modification of parameters in claim 10 is to enable the e-mail application to use a wireless connection. Nothing in Narayanaswami teaches modifying parameters of a handheld computer so that a wireless connection can be used.

With regard to claim 15, Narayanaswami does not disclose modifying parameters of the handheld computer, by the launching application, so that the application is able to run on the handheld computer. Narayanaswami teaches converting data in one format to data in a second format so that it can be easily viewed on a smaller device. Claim 15 recites “modifying parameters of the handheld computer...”, whereas Narayanaswami teaches modifying data transmitted to the smaller device. Further, Applicants respectfully submit that the parameters in Claim 15 are modified by the launching application which is on the handheld computer, whereas Narayanaswami teaches modifying data on one device using transcoder software and then

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transmitting the converted data to a second device to be used by the second device. Further still, Applicants respectfully submit that the modification of parameters in claim 15 is to enable the application to run on the handheld computer. Nothing in Narayanaswami teaches modifying parameters of a handheld computer so that the application can be run on the handheld computer.

Applicants note that if the references do not teach all of the claim limitations recited, the claims are patentable under 35 U.S.C. §102. Thus, Applicants respectfully request the allowance of independent Claims 10 and 15 and their respective dependent claims.

Claim Rejections – 35 U.S.C. § 103(a)

In the Office Action, claims 16-20 have been rejected under 35 U.S.C. § 103 as being unpatentable over Narayanaswami. Applicants respectfully submit that all of the claims rejected under 35 U.S.C. § 103(a) are dependent claims which depend from Claim 15. Accordingly, Applicants have not specifically responded to the claim rejections under 35 U.S.C. § 103 but are reliant on the fact that the Applicants believe claim 15 to be allowable. Therefore, Applicants believe that claims 16-20 are also allowable for at least the same reasons.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit

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Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 11/23/2005

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